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IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Applicant(s): S. Flickinger
Application No: 10/706,748
Filing Date: November 12, 2003
Attorney Docket No: 17511 C
Title: PLUGGABLE MODULE AND
RECEPTACLE

Art Group: 2839

Examiner: Dinh, Phuong K.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addresses to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 16, 2005.


Stephen J. Driscoll

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO FINAL OFFICE ACTION DATED DECEMBER 16, 2004

Dear Sir:

This reply is being filed timely in response to the Final Rejection of December 16, 2004, in connection with the above-identified patent application. The Commissioner is hereby authorized to charge fees associated with this action and application in general to Deposit Account No. 19-5425.

Request for Reconsideration under 37 C.F.R. §1.111

Applicants respectfully request that the Examiner reconsider her position with respect to her rejection of Claims 26-31 and 34-37. Specifically, in rejecting these claims, the Examiner has maintained her rejection as set forth in the first Office Action. The Examiner stated that “*Smith* discloses the claimed invention except for a connector interface at the front of said housing, said connector interface being adapted for receiving a connector of an electrical or optical conductor.” The Examiner states, however, that “*Hall* disclosed a connector interface of the front of the housing, the connector interface being adapter for receiving a connector of an electrical or optical connector.” The Examiner therefore concludes that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Smith* to provide the connector interface at the front of the housing as taught by *Hall so as to supply signal to the system*” (emphasis added).

In reply to Applicants’ arguments submitted previously, the Examiner stated as follows:

Smith is used for general teaching of plug and electronic modules with printed circuit board not for the very specific video game environment disclosed. *Hall* discloses that it is known to use such electronic modules with front wall connectors for auxiliary electrical devices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify to apply the same to *Smith* could be then used for video games but in a different manner. For example switch like that at 45¹ could be connected to cartridge 26.

As understood by the applicants, the examiner’s rejection seems to be based on a combination of *Smith*, which discloses a module containing a circuit board, and *Hall*, which discloses a module having a plug interface. The Examiner stated that it would be obvious to provide the plug interface on the module of *Smith* to facilitate, for example, a switch. In other words, the motivation for modifying the module of *Smith* to have a plug

¹ It is worthwhile to mention that the Applicants are unable to locate the switch 45 referred to by the Examiner.

interface is to facilitate additional input into the video game device to which the module is connected.

In reply, Applicants submit that (1) the prior art references are not analogous to the claimed invention, and (2) the examiner has used hind sight in combining the references rather than motivation found within the references themselves.

Smith and Hall are Not Analogous Prior Art

The applicants respectfully submit that *Smith* and *Hall* are not valid references to support a rejection under 103(a) because they are not analogous prior art. "To rely on a reference as a basis for rejection of an applicants' invention, the reference must either be in the field of the applicants' endeavor or, if not, then must be reasonably pertinent to the particular problem with which the inventor was concerned." M.P.E.P. §2141.01(a) citing *In re Oetiker*, 977 Fed 2nd 1443 (Fed. Cir. 1992). In this case, *Smith* and *Hall* are neither in the applicants' field, nor are they reasonably pertinent to the problem with which the inventor was concerned.

The invention of the present application is directed to a module in the telecommunications field. As set forth in the application's Field of Invention:

The present invention relates generally to electronic connector systems and, more specifically, to low-profile connector systems for pluggable electronic modules, such as transceiver modules for high speed fiber optical and copper communications.

More specifically, the claimed invention is directed to a module that "facilitates miniaturization and high operating frequencies by effectively shielding EMI emissions to eliminate leaks" (Appln. Summary of Invention). To this end, the module of the claimed invention comprises walls to shield the circuit board it contains and prevent EMI emissions. The module also comprises, in a preferred embodiment, grounding tabs to channel EMI to ground.

On the other hand, *Smith* is directed to a video game apparatus for connection to a standard television set. Specially, as set forth in its Field of Invention:

[*Smith*] relates generally to video game apparatus and, more particularly, to a self-contained video signal generating device for use in association with a standard black-and-white or color television set and which includes preprogrammed data relating to several selectable games as well as means for receiving a preprogrammed cartridge containing other data that may be selected to provide additional game play.

Hall is directed to a cathode ray tube display terminal. As set forth in its Field of Invention:

The invention [of *Hall*] relates generally to cathode ray tube display terminals and more specifically to the protection of the logic board during shipment and during normal operation of the terminals, thereby allowing customer replacement of the logic board without damage to the logic board or injury to the customer.

Therefore, *Smith* relates to video games and *Hall* relates to a CRT terminal. Neither of these fields relates to telecommunications, much less to a module for telecommunications which is configured to prevent EMI emission.

Since *Smith* and *Hall* lay outside the field of applicant's endeavor, the issue becomes whether the references are reasonably pertinent to the particular problem with which the inventor was concerned. The claimed invention is aimed at a module which facilitates miniaturization and EMI protection. It is inconceivable to Applicants why one skilled in the art would look to *Smith* and *Hall* to solve a problem of configuring a module which is suitable for miniaturization and EMI reduction. For example, as mentioned above, *Smith* is directed at a preprogrammed cartridge for expanding the type of video games available for play, and *Hall* is directed to the protection of the logic board of a CRT terminal during shipment and during normal operation of the terminals. Neither reference mentions, in any way, the need to miniaturize and control EMI. Indeed, the components of *Smith* and *Hall* operate at frequencies that do not result in significant EMI. Therefore, there is not a scintilla of evidence suggesting that one skilled in the art would turn to *Smith* and *Hall* to solve the problem of designing a module for miniaturization and EMI reduction.

Therefore, since *Smith* and *Hall* are not in the field of the claimed invention, and since one skilled in the art would not find the references reasonably pertinent to solve the problem with which the inventor was concerned, *Smith* and *Hall* are not analogous art. Accordingly, the references should be removed and the claims allowed.

There is No Motivation to Combine *Smith* and *Hall*

Even if *Smith* and *Hall* are considered analogous art (which they are not), there is no motivation to combine the module of *Smith* with the plug interface of *Hall*. To establish a *prima facie* showing of obviousness, there must be motivation for combining the references in accordance with the claimed invention. Furthermore, as set forth in MPEP §2143, the prior art must suggest the desirability of the claimed invention. This section states in relevant part:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applying this precedent to the present case, the motivation to modify the module of *Smith* to have the plug interface of *Hall* must come from *Smith* and *Hall*, from the need to configure a module for miniaturization and EMI shielding, or from knowledge of one skilled in the art.

Here, there is no motivation in *Smith* or *Hall* to modify the module to have a plug interface. For example, *Smith* states quite clearly that the module or cartridge 28

provides additional memory to increase the selection of games available to the user. *Smith* states in its Summary of Invention:

Another object of [*Smith*] is to provide a video game apparatus which can be selectively programmed, through the use of interchangeable preprogrammed electronics containing cartridges or the like, to include data relating to a large plurality of various games.

(col. 1, ll. 42-48). In the Detailed Description, *Smith* adds:

The cartridge 28 includes preprogrammed electronics which cooperate with the permanent electronics of the console to enable games other than those contained in the console circuitry to be played.

(Col. 3, ll. 3-7.) *Smith* also states that the user control for the video games is inputted by means different from the cartilage. Specifically, *Smith* states that "game selection inputs are entered through the selection buttons 24, player control inputs are made through the hand controllers 12 and 14, and interchangeable game capability is provided by means of the cartridge 28."

(Col 3, ll. 47-51.) Therefore, it is incontrovertible that *Smith* discloses that the purpose of the cartridge is to provide additional games. There is no suggestion that it can be used as an input for a switch as suggested by the examiner, nor is there a suggestion that such a use would be desirable. *To the contrary*, to modify the cartridge of *Smith* to make it suitable for an input device would destroy the object of the invention of providing a memory module, and render the input devices already disclosed superfluous.

Furthermore, the need to configure a telecommunication module to facilitate miniaturization and EMI protection does not provide motivation for combining the module of *Smith* with the plug interface of *Hall*. It is inconceivable why one would take a video game memory module and add a plug interface to it in response to the need to provide a telecommunication module that facilitates miniaturization and EMI shielding. Indeed, as mentioned above, neither *Smith* nor *Hall* is even relevant to telecommunications. Therefore, since there is no motivation to combine *Smith* and *Hall*, the rejection should be withdrawn and the claims allowed.

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In light of the above remarks, an early and favorable response is earnestly requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'SJD', is written over a horizontal line.

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